



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,133	05/31/2001	Joshua Robert Nemeth	EL599431223U	9545

7590 04/28/2004

Christensen O'Connor Johnson & Kindness
Suite 2800
1420 Fifth Avenue
Seattle, WA 98101-2347

EXAMINER

DICUS, TAMRA

ART UNIT PAPER NUMBER

1774

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/857,133

Applicant(s)

NEMETH, JOSHUA ROBERT

Examiner

Tamra L. Dicus

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-9 and 11-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9 and 11-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Art Unit: 1774

DETAILED ACTION

The Examiner acknowledges cancellation of claims 6 and 10. The Examiner acknowledges the declarations and the RCE.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-5, 7-9, and 11-42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40 of U.S. Patent No. 6,605,338 to Romanic et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because the referenced copending application and the instant application are claiming common subject matter, as follows: "An article/security document and/or device having a smooth highly reflective layer...a reflectivity of at least 60 gloss units...raised printed image having a height of at least 10 microns...printing image being printed using ink". All patented claims address the same raised print(ed) image, printed image height of at least 10 microns, and gloss unit value of 60 as does the instant application.

Claims 1-42 directed to an invention not patentably distinct from claims 1-40 of commonly assigned U.S. Pat No. 6605338 to Romanic et al.

Art Unit: 1774

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302).

Commonly assigned assignee discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78(c) and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Response to Arguments

Applicant alleges the rejection based on US patent application 09/806,966 is clearly in error.

The Applicant points to the declarations of Bruce Alfred Hardwick and Wayne Kevin Jackson as belief that the rejection is in error. Applicant discusses the declaration of Dr. Hardwick, stating the present intaglio printing ink has no color having extremely low chroma and lightness values, whereas U.S. Patent No. 6,605,338 uses a highly colored intaglio printing ink having high chroma and lightness values of at least 30 chroma units and 50 lightness units and alleges the

Art Unit: 1774

visual effects produced are different from the instant application. The Applicant has not persuasively argued. The patent and the instant application are claiming common subject matter, as follows: "An article/security document and/or device having a smooth highly reflective layer...a reflectivity of at least 60 gloss units...raised printed image having a height of at least 10 microns...printing image being printed using ink". Applicant actually claims no highly colored ink. Applicant claims ink with chroma value of at least 30 and/or a lightness value of at least 50. This does not say colored or highly colored. Additionally, it could be colored and also transparent. The chroma value is not necessarily claimed. Therefore, the Examiner sees no highly colored ink that is not transparent. The claims are therefore obvious over claims of the instant application.

Applicant points to Exhibit 2 of Dr. Harwick's Declaration as a sample of a security document incorporating the invention of the patent which is called an intaglio contrast effect (ICE), where applicant alleges the ICE effect is produced by applying raised lines or dots of a highly colored intaglio printing ink (red in the sample of Exhibit 2) to a highly reflective background (a gold reflective patch in the sample of Exhibit 2). Applicant further alleges the part of the security document exhibiting the ICE effect is towards the bottom left-hand corner of the sample containing the letters "rency" and a complex line structure in red intaglio ink on the gold patch and that when the sample is viewed at an angle substantially perpendicular to its surface, the gold reflective patch appears very bright and the letters "rency" do not appear as bright. Applicant continues to allege it is also important to note that the raised printed image formed by the highly colored red intaglio ink is visible at all viewing angles, whereas the effect produced by the raised lines or dots of a transparent or translucent intaglio printing ink to a background of a

Art Unit: 1774

smooth highly reflective layer produces a disappearing effect that applicant calls TIDE (transparent intaglio disappearing effect). The Applicant points to Exhibit 3 of Dr. Hardwick's declaration as an example of the present invention where Exhibit 3 includes a pattern of raised lines printed in a transparent ink onto a highly reflective gold background above the number 500,000. Applicant discusses the sample being viewed from a direction perpendicular to the surface of the substrate, and alleges the image formed by the transparent intaglio ink is essentially invisible. Applicant further alleges when one tilts the image, the image formed by the raised lines of transparent ink becomes visible. Applicant also discusses the window of high reflection within the specification and states the highly reflective gold background appears a bright gold color and the part of the image formed by the raised printed lines of transparent or translucent ink is visible owing to the specular scattering of light caused by the raised transparent lines. However, when the document is tilted to more oblique angles, the image disappears. Applicant further discusses the sample of Exhibit 3 also including non-reflective indicia, the letters "BNR," printed on the highly reflective gold background. This feature is claimed in dependent Claims 23, 24, 27, 28, 36, 37, 40, and 41. Conclusively, Applicant believes the raised intaglio printed image has the effect of blurring the non-highly reflective indicia within the window of high reflection. Declarant Hardwick argues that the patent involves the application of raised lines or dots of a highly colored intaglio printing ink that produces the ICE, further arguing that the intaglio printing ink is high colored by pointing to the wording in instant claim 1 that states "said printed image being printed using ink of a hue having a chroma value of at least 30 chroma units and/or a lightness of at least 50 lightness units". However, the Examiner does not agree to the alleged difference that Applicant purports or the limitations of instant claim 1 as

Art Unit: 1774

Declarant Hardwick contends because the instant claim 1 includes the language “**and/or** lightness of at least 50 lightness units”, which would obviously indicate a translucency of some degree and not a brighter red or gold color as applicant contests. Declarant Hardwick also contends the visual effect produced by applying the highly colored intaglio ink to a highly reflective background is a contrast effect such that when the printed image is viewed at an angle perpendicular to the light source, the highly reflective background, e.g. a gold coloured reflective patch, appears very bright whereas the part of the image formed by the highly coloured intaglio ink, e.g. a red colour, does not appear very bright in comparison to the gold background. However, when the viewing angle changes from the perpendicular through oblique viewing angles, e.g. when the security document is tilted, the gold patch becomes duller. The Examiner does not agree with this alleged difference. Again, Applicant claims ink with chroma value of at least 30 and/or a lightness value of at least 50. This does not say colored or highly colored. Declarant Hardwick points to Exhibit 2 showing an intaglio contrast effect as in accordance with the patent. The Examiner also acknowledges Exhibit 3. However, none of the Exhibits show a difference between applicant’s invention and the patent. No data was presented in a comparative fashion to indicate any alleged difference. Therefore, the Examiner does not believe the declaration of Hardwick nor the arguments of applicant to be persuasive. Declarant Hardwick further alleges a disappearing image is made from the translucent intaglio ink of the instant application, which Declarant believes is different from what the patent claims. The Examiner does not agree because Applicant has not shown that the patent claims do not have ink that is not transparent.

Art Unit: 1774

Applicant argues what Declarant Jackson explains in the declaration, stating a transparent ink of the instant application would have a zero chroma value and is therefore different from the patent because the patent claims at least 30 chroma units and/or a lightness of at least 50 lightness units. However, the Examiner believes that if the ink of the patent claims a lightness of at least 50 lightness units, then the ink of the application could be transparent or essentially 50. Declarant Jackson also discusses the visual effects of the instant application, alleging the transparent ink of the raised printed image causes a different effect outside a window of high reflection versus the raised printed image from the ink of the patent which when viewed is dull red on a bright gold background when viewed at a substantially perpendicular viewing angle, and bright red on a dull gold background when the viewing to more oblique angles. The Examiner does not agree. The Applicant has no evidence of this occurrence. Further, whether the image is visible at an angle within a window and non-detectable outside the window goes to intended use, which is given little weight in the patentability determination. Further, applicant has not defined the window or the angles at which this effect is supposed to occur.

In regards to the common ownership issue, the Applicant acknowledges there is a relationship between the two legal entities, therefore the burden is on the Applicant to provide a showing of this common relationship. It appears that the assignees have a common relationship. That one entity owns the other means that they are commonly owned. Applicant is reminded to submit the proper documentation showing this. In order for the Examiner to resolve this issue, the assignee is required under 37 CFR 1.78(c) and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was

Art Unit: 1774

made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tamra L. Dicus
Examiner
Art Unit 1774

April 20, 2004

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

